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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Mapcad, Inc.

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Serial No. 78312371

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Jeffrey Greger of Lowe Hauptman & Berner, LLP for Mapcad, Inc.

Patty Evanko, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

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Before Drost, Zervas, and Kuhlke, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On October 10, 2003, applicant Mapcad, Inc. applied to register the mark MAPCAD (in typed or standard character form) on the Principal Register for goods ultimately identified as "computer software for professionals in the field of civil engineering excluding software used in drafting and mapping in the field of photogrammetry" in

Class 9.[1] During the prosecution of the application, the examining attorney accepted applicant's amendment of the application to seek registration on the Principal Register under the provision of Section 2(f) because its mark had acquired distinctiveness. The examining attorney ultimately refused to register applicant's mark for two reasons. First, the examining attorney determined that under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)), applicant's mark was likely to cause confusion, mistake, or to deceive because of a registration for the mark CADMAP (typed or standard character drawing) for "computer software for use in the field of drafting, map drawing and photogrammetry" in Class 9.[2] The examining attorney also refused to register applicant's mark because applicant's identification of goods did not specify the function of the software.

When the refusals were made final, applicant filed an appeal.

We begin by addressing the refusal to register on the ground that applicant's identification of goods is not definite. 37 CFR § 2.32(a)(6). TMEP § 1402.03(b) (2d ed.

[1] Serial No. 78312371. The application alleges a date of first use and a date of first use in commerce of April 1, 1999.
[2] Registration No. 1,611,106 issued August 28, 1990, renewed.

rev. April 2005) specifically addresses the identification of goods that involve computer software.

> Any identification of goods for computer programs must be sufficiently specific to permit determinations with respect to likelihood of confusion. The purpose of requiring specificity in identifying computer programs is to avoid the issuance of unnecessary refusals of registration under 15 U.S.C. § 1052(d) where the actual goods of the parties are not related and there is no conflict in the marketplace. See In re Linkvest S.A., 24 USPQ2d 1716 (TTAB 1992). Due to the proliferation of computer programs over recent years and the degree of specialization that these programs have, broad specifications such as "computer programs in the field of medicine" or "computer programs in the field of education" should not be accepted unless the particular function of the program in that field is indicated. For example, "computer programs for use in cancer diagnosis" or "computer programs for use in teaching children to read" would be acceptable.
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> Typically, indicating only the intended users, field, or industry will not be deemed sufficiently definite to identify the nature of a computer program. However, this does not mean that user, field or industry indications can never be sufficient to specify the nature of the computer program adequately. For example, "computer programs in the field of geographical information systems" would be acceptable. Geographical information systems, also known in the industry as GIS, are well-defined computer applications that do not need further definition.

While applicant "submits that [it] has complied with the requirement to identify computer software with specificity in accordance with TMEP § 1402.03(d) by adopting language as suggested in the TMEP," (Reply Brief at 2), we agree with the examining attorney that applicant's identification of goods simply identifies its computer

software as being for professionals in the field of civil engineering. As indicated in the TMEP, this is not definite. The examining attorney, in her first Office action, has submitted a definition of civil engineer as "an engineer whose training or occupation is in the design and construction especially of public works (as roads or harbors)." The "Introduction to Civil Engineering" webpage in the record identifies the subfields of civil engineering as including environmental engineering; geotechnical engineering; structural engineering; photogrammetry, surveying and mapping; water resources engineering; transportation; and construction management. This evidence demonstrates that the field of civil engineering is broad and that use of software in one area of civil engineering would not necessarily mean that there was confusion with a similar trademark used on different software used in other fields of civil engineering. Therefore, we affirm the examining attorney's refusal to register on the ground that applicant's identification of goods is not acceptable because it did not specify the function of the software.[3]

[3] In its Reply Brief at 3, applicant proposed an amendment to the identification of goods to address the examining attorney's objection. We deny applicant's belated request to remand the application. This request is untimely and it is not clear that it would overcome the examining attorney's objection. TBMP §§ 1205.01 and 1209.04 (2d ed. rev. 2004).

Next, we address the question of likelihood of confusion and we consider the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

First, we will consider the marks of applicant and registrant. Applicant's mark is for the term MAPCAD while registrant's mark consists of the term CADMAP. Neither mark claims any design or stylization as a feature. The marks also consist of the identical six letters and, indeed, the identical two terms, CAD and MAP. The only difference between the marks is that applicant has the term MAP followed by the term CAD, while registrant reverses the order.

However, we must point out that these marks are not composed of arbitrary letters or terms. The term CAD is a

recognized abbreviation for software that stands for "computer-aided design," which is the "capability of a computer to be used for automated industrial, statistical, biological, etc. design through visual devices." Sippi, *Computer Dictionary* (3d ed. 1984).[4] Registrant's identification of goods specifies that a feature of the software is "map drawing." Applicant's specimen demonstrates that its software is the "only product that provides a complete and standardized means for creating and managing plans. Creating Final Maps and Plat Maps has never been easier." Both applicant's and registrant's identified goods would include software using computer-aided design to create maps. In her brief, the examining attorney points out that "applicant correctly notes that in both marks the term CAD is a generic acronym which refers to 'computer assisted design' or 'computer assisted drafting' and MAP is a common term." Brief at unnumbered page 4. In addition, applicant has requested registration under the provision of Section 2(f), which is an admission that its mark is not inherently distinctive. Yamaha Int'l Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001,

[4] We take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

1005 (Fed. Cir. 1988) ("Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact").[5]

Inasmuch as these marks are composed of the identical terms CAD and MAP in different order, they are not identical and we must consider how similar the marks are. Recently, the board noted that the "mere commonality of "first" and "care" in the parties' marks (moreover, in the reverse order) is an insufficient basis on which to find likelihood of confusion." CareFirst of Maryland Inc. v. FirstHealth of the Carolinas Inc., 77 USPQ2d 1492, 1511 (TTAB 2005). Similarly, the District Court for the Eastern District of Virginia held that the marks CAREFIRST and FIRST CARE, while "mirror images of each other," were not confusingly similar. CareFirst of Maryland Inc. v. First Care PC, 350 F. Supp.2d 714, 73 USPQ2d 1833, 1839-40 (E.D. Va. 2004), aff'd, 434 F.3d 263, 77 USPQ2d 1577 (4th Cir. 2006) (First Care). Cases involving the transposition of parts of the marks have reached different conclusions based

[5] With its appeal brief, applicant submitted numerous registrations in an attempt to show that MAP and CAD are in widespread use. The examining attorney has objected to the submission of this evidence. We agree and sustain the examining attorney's objection to this untimely submission of evidence. 37 CFR § 2.142(d).

on the individual facts of the case. Compare First Care (CAREFIRST and FIRST CARE); In re Best Products Co., Inc., 231 USPQ 988 (TTAB 1986) (BEST JEWELRY and design and JEWELERS' BEST); In re Akzona Incorporated, 219 USPQ 94 (TTAB 1983) (TOUCH O' SILK and SILKY TOUCH); and In re Mavest, Inc., 130 USPQ 40 (TTAB 1961) (SQUIRETOWN and TOWN SQUIRES) (no confusion in these cases) with Carlisle Chemical Works, Inc. v. Hardman & Holden Limited, 434 F.2d 1403, 168 USPQ 110 (CCPA 1970) (COZIRC and ZIRCO); Bakers Franchise Corp. v. Royal Crown Cola Co., 404 F.2d 985, 160 USPQ 192 (CCPA 1969) (DIET-RITE and RITE-DIET); In re Wine Society of America Inc., 12 USPQ2d 1130 (TTAB 1989) (THE WINE SOCIETY OF AMERICA and AMERICAN WINE SOCIETY); and In re Nationwide Industries Inc., 6 USPQ2d 1882 (TTAB 1988) (RUST BUSTER and BUST RUST) (likelihood of confusion in these cases).

In this case, the marks are obviously similar to the extent that they are composed of the same terms CAD and MAP. In addition, the similarity of the initial word can often lead to a conclusion that the marks are similar. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("The presence of this strong distinctive term as the first word in both parties' marks renders the marks

similar"). This is not the case here. We cannot overlook the difference in appearance, pronunciation, and commercial impression created when the terms are combined. More importantly, the examining attorney has maintained that the term CAD is generic and the other term, MAP, is common inasmuch as both applicant's and registrant's goods include software for creating maps using computer-aided design. Therefore, neither term is particularly strong when used in association with the identified goods. Regarding the meaning, their similarity is based on the fact that both could describe a mapping feature that includes computer-aided design. Therefore, we find that while the marks are similar, there are also significant differences.

We next consider the goods of applicant and registrant. Applicant's computer software is limited to software for professionals in the field of civil engineering excluding software used in drafting and mapping in the field of photogrammetry. Registrant's goods are computer software for use in the field of drafting, map drawing and photogrammetry. We must consider the goods as they are described in the identification of goods in the application and registration. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that

the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

We first consider whether the goods overlap because, if there is no overlap, confusion would be unlikely. Applicant's goods are computer software for professionals in the field of civil engineering excluding software used in drafting and mapping in the field of photogrammetry. The identification of goods limits the goods to software (1) for professionals, (2) in the field of civil engineering, and (3) not involving drafting and mapping in the field of photogrammetry.

Photogrammetry involves "measuring or drawing from photographs: Making measurements or scale drawings from photographs. Especially using aerial photographs in the construction of maps." Final Office Action, Encarta dictionary attachment.

> Digital photogrammetry is the science of obtaining high precision measurements from photographs and other forms of imagery. This ranges from aerial photographs for mapping, through close-range photos for medical measurements, to the use of digital images in sophisticated digital work workstations. Digital

> photogrammetry is revolutionizing the way we think about and work with maps.
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> Photogrammetry has evolved from analog to analytical to digital (softcopy) photogrammetry. The main difference between digital photogrammetry and its predecessors – analog and analytical – is that it deals with digital imagery directly rather than (analog) photographs. However, the mathematics of data processing models (e.g., orientation, triangulation, etc.) used in digital photogrammetry has been well established.
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> Photogrammetry has been used for a variety of applications, ranging from engineering design to natural resource and environmental inventory to hydrographic survey to archaeological mapping. Most topographic maps available today were created using photogrammetry, which is considered the primary approach to GIS base data collection and updating.

Final Office Action, Bohannan Huston webpage attachment.

Registrant's software is for use in the field of drafting, map drawing and photogrammetry. The examining attorney argues that inasmuch as "both goods are computer software for mapping, and the registrant's software uses photogrammetry, which is used in civil engineering, the goods are closely related." Brief at unnumbered p. 8. Furthermore, the examining attorney maintains that "the field of 'drafting, map drawing and photogrammetry' can include computer software for map drawing that utilizes photogrammetry as well as computer software for map drawing that does not use photogrammetry." Id. On the other hand, applicant argues that "its software is for mapping but …

computer mapping software includes a subset of photogrammetry which Applicant excludes in its application and for practical purposes Applicant does not compete or use." Reply Brief at 5. In addition, applicant maintains that the examining attorney has "broadened the coverage of the registered CADMAP mark to include anything related to mapping or drawing, thereby giving short shrift and rendering meaningless the term 'photogrammetry' as an alleged third field of use." Id.

Applicant has also submitted 16 declarations from people in civil engineering-related professions. A sample from a declaration is set out below.

> The MAPCAD brand product I am familiar with is not used for photogrammetry. Conversely, CADMAP is used strictly for photogrammetry… The differences in the functional use of the respective softwares make it unlikely that a professional in the field of civil engineering would believe the two brands are affiliated.

We are constrained to agree with the examining attorney that registrant's identification of goods does not limit its software to the field of photogrammetry. While not a model of clarity, the identification sets out three separate functions and not a single field that would be known as mapping, drafting, and photogrammetry and require the presence of all three functions. The declarants' statements about the registrant's goods do not address the

goods as they are identified but instead as they are apparently used. As discussed previously, this is not the proper test for analyzing likelihood of confusion issues before the board. Therefore, we must assume that there is at least some overlap inasmuch as registrant's goods could similarly include mapping and drafting software for civil engineering professionals not in the field of photogrammetry.

At this point, we address the final significant factors, which include the sophistication of the purchasers and the conditions of sale. Applicant argues that its software is purchased by sophisticated civil engineers after careful consideration. Brief at 12. Applicant's 16 declarations include statements to the effect that: "As a civil engineer I make careful examinations and research the products I use in connection with my trade when it involves software programs in the field of computer assisted drawing which cost in excess of a thousand dollars." Also, the examining attorney's evidence shows that "civil engineers are involved in the precise measurements of the earth's surface to obtain reliable information for locating and designing engineering projects." Final Office Action, Civil Engineering Research Institute webpage. This evidence supports applicant's argument that purchasers of

the overlapping products, civil engineering professionals, would be sophisticated purchasers who would carefully consider software used in their profession especially software related to obtaining precise measurements. This factor favors applicant. See Palm Bay Imports, 73 USPQ2d at 1695 ("Purchaser sophistication may tend to minimize likelihood of confusion").

When we consider all the evidence of record, we conclude that there is no likelihood of confusion. While the marks contain the same terms, these terms are admittedly generic or common. They are used in reverse order and the use of common terms in this order changes their commercial impression, appearance, and sound. To the extent their meanings are similar, it would be because both could have similar descriptive meanings. Furthermore, the overlap in the goods is limited to civil engineering professionals. While it is not difficult to assume that these professionals are sophisticated purchasers who exercise care in these types of purchases, we have declarations in the record from 16 professionals that establish that this is the case. Under these circumstances when these professionals encounter the marks CADMAP and MAPCAD for mapping software, they would not assume that these products come from an associated or related source

simply because they use the generic term CAD and the common term MAP for mapping and drafting software.[6]

Decision: The examining attorney's refusal to register applicant's mark because of Registration No. 1,611,106 is reversed. The refusal to register applicant's mark because the identification of goods is not definite is affirmed.

[6] While we were able to decide the issue of likelihood of confusion in this case despite the indefiniteness of applicant's identification of goods, we add that the identification remains indefinite. Future applications may be unnecessarily refused registration because of the indefiniteness of applicant's identification of goods.